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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,641	10/17/2003	Glen T. Anderson	SC30X-US	1956
60723 7590 09/09/2008 AVON PRODUCTS, INC. AVON PLACE SUFFERN, NY 10901				
EXAMINER CHOI, FRANK I				
ART UNIT 1616		PAPER NUMBER		
NOTIFICATION DATE 09/09/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENT.DEPARTMENT@AVON.COM

Office Action Summary

Application No.

10/688,641

Applicant(s)

ANDERSON ET AL.

Examiner

FRANK I. CHOI

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/27/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 9938483 (Abstract) in view of Lapinet et al. (US Pat. 3,978,213), Tomita et al. (US Pat. 5,314,873), Peyronel et al., WO 9204420 (Abstract), WO 97/27835, Moller et al. (US Pat. 4,496,536), JP 09030946 and WO 96/17605.

WO 9938483 teach a method of treating skin comprising Artemia salina extract combined with additional cosmetic active ingredients and supporting materials which results in a synergetic effect against the environment by strengthening the immune system, providing UV protection and stimulating skin regeneration (Abstract).

Lapinet et al. teach a method of treating skin comprising cyclic adenosine monophosphate which is involved in the regulation of function and metabolism and is a "second messenger" (column 1, lines 18-26, column 3, lines 1-26, column 4, lines 1-7).

Tomita et al. teach a method of treating skin comprising hydrolyzed milk protein which has a proliferation activating property on cutaneous cells (column 5, lines 16-22, column 6, lines 12-68, columns 7-27, column 28, lines 1-50).

Peyronel et al. teach that a component of plankton extract, dinucleotide tetraphosphate, stimulates the synthesis of keratins and fibronectin in skin cells (Abstract).

WO 9204420 teach that sunflower seed extract exhibits superior antioxidant activity versus other antioxidants such as ascorbic acid and tocopherol and is highly safe when used in pharmaceuticals (Abstract).

WO 97/27835 discloses a personal care composition which is used to ameliorate skin dryness, wrinkling, chapping and aging and enhance the quality and flexibility of skin which is an aqueous liquid comprising a lipid composition, such as phytol, surface active agent and deposition aid (Page 1, lines 1-8, Page 3, lines 20-35, Page 4, line 1, Page 12, lines 12-18)

Moller et al. disclose emulsions containing phytol which is effective in treating seborrhea (Column 1, lines 45-68, Column 2, lines 1-26).

JP 09030946 teaches the use of extracts Andrographis in oil-in-water preparations for skin lightening which inhibits melanin formation and tyrosinase (paragraphs 0004-0035).

WO 96/17605 teach that extracts of Andrographis contain andrographolide compounds (pg. 6).

The prior art discloses a method of treating skin comprising Artemia salina extract combined with additional cosmetic active ingredients and supporting materials which results in a synergetic effect against the environment by strengthening the immune system, providing UV protection and stimulating skin regeneration. The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the claimed method of improving the asesthetic appearance of the skin in which the composition contains andrographolide. However, the prior art amply suggests the same as the use of andrographolide for treatment of skin which lightens the skin, that plankton extract rejuvenates skin, that sunflower seed extract has antioxidant properties, that phytol is effective in treating seborrhea,

that adenosine monophosphate regulates the function and metabolism of skin, that hydrolyzed milk protein is used to treat skin and has a proliferating property on cutaneous cells and that compositions which ameliorate skin dryness, wrinkling, chapping and aging and enhance the quality and flexibility of skin can contain phytol. Further, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art to prepare a composition for treating skin with the expectation that the composition would be effective for treating wrinkles, rejuvenating skin and ameliorating skin dryness, chapping, aging and enhancing the quality and flexibility of the skin.

The Examiner has duly considered the Applicant's arguments but deems them unpersuasive.

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, held the following:

(1) the obviousness analysis need not seek out precise teachings directed to the subject matter of the challenged claim and can take into account the inferences and creative steps that one of ordinary skill in the art would employ;

(2) the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents;

(3) it is error to look only the problem the patentee was trying to solve-any need or problem known in the filed of endeavor at the time of invention and addressed by the prior art can provide a reason for combining the elements in the manner claimed;

(4) it is error to assume that one of ordinary skill in the art in attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem-

common sense teaches that familiar items may have obvious uses beyond their primary purposes, and in many cases one of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle (one of ordinary skill in the art is not automaton);

(5) it is error to assume that a patent claim cannot be proved obvious merely by showing that the combination of elements was “obvious to try”. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396, 1397 (U.S. 2007).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The Applicant argues that there is no showing by Examiner that andrographolide compounds have any utility in reducing the claimed skin characteristics. However, there is no requirement that the Examiner show that andrographolide compounds have the same utility as that claimed by the Applicant. This is a rejection based on the combined teachings of the prior art which combined teachings which do suggested that the combined prior compositions would be effective in improving the skin characteristics as indicated above. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or

to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Applicant's working example tested the combined ingredients, not andrographolide alone, as such, there is no evidence that the andrographolides alone would have improved the claimed skin characteristics. Since there is no evidence that the utility of andrographolide is critical to the invention, the fact that the prior art disclose a different reason for using andrographolide in a skin treating composition does not overcome the rejection. Further, the fact that non-andrographolide ingredients are not specifically set forth in claim 43 does not overcome the rejection. Claim 43 does exclude said ingredients and, in fact, the dependent claims contain the non-andrographolide ingredients.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Terminal Disclaimer

The terminal disclaimer filed on 3/27/3008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Application 11/040,534 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Art Unit: 1616

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a compressed schedule and may be reached Monday, Tuesday, Thursday, Friday, 6:00 am – 4:30 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Johann R. Richter, can be reached at (571)272-0646. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank Choi
Patent Examiner
Technology Center 1600
September 6, 2008

/John Pak/
Primary Examiner, Art Unit 1616